



UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/580,493	12/29/95	BERNA	P

PHILLIPPE JEAN HENRI BERNA
MAS LIOTARD LES BROUSSES
F 30410
MOLIERES SUR CEZE
FRANCE

32M1/1017

EXAMINER

HUGHES, S

ART UNIT

PAPER NUMBER

3206

DATE MAILED: 10/17/96

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/580,493

Applicant(s)

Berna

Examiner

S. Thomas Hughes

Group Art Unit

3206



☒ Responsive to communication(s) filed on Mar 20, 1996

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-18 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed:

☒ Claim(s) 1-18 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☒ The proposed drawing correction, filed on Sep 5, 1995 is ☒ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☒ received in Application No. (Series Code/Serial Number) 07/938,211.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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Preliminary Matters

1
2 1. This office is based on the following: claims 1-6, 9, 10 and 12-18 filed by
3 fax on March 21, 1996; claims 7, 8 and 11 filed in applicant's letter dated June
4 10, 1995; the substitute specification filed September 5, 1995 (which has been
5 entered); drawing sheets 1-3 as originally filed; drawing sheet 4 filed September 5,
6 1995 (approved). These claims and specification, although they may not be in
7 proper format, are being entered for the purpose of facilitating prosecution of this
8 pro se case.

9
10 ***Drawings***

11 2. Since allowable subject matter has been indicated, applicant is encouraged
12 to submit formal drawings in response to this Office action. The early submission
13 of formal drawings will permit the Office to review the drawings for acceptability
14 and to resolve any informalities remaining therein before the application is passed
15 to issue. This will avoid possible delays in the issue process.

16
17 ***Specification***

18 3. The substitute specification filed September 5, 1995 is objected to because
19 many phrases are not in proper idiomatic English. For instance, lines 31 and 32 of
20 the specification read awkwardly and are not written in proper idiomatic English.

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1 Correction of all such instances of improper use of the English language in the
2 specification, the number of which is too great to list individually, is required.

3
4 ***Claim Rejections - 35 USC § 112***

5 4. Claims 1-15 are rejected under 35 U.S.C. 112, first paragraph, as containing
6 subject matter which was not described in the specification in such a way as to
7 enable one skilled in the art to which it pertains, or with which it is most nearly
8 connected, to make and/or use the invention. Particularly, it is not clear how the
9 invention can work if a buffer is secured to only one of the arms as in claims 1
10 and 2.

11 5. Claims 12-15 are rejected under 35 U.S.C. 112, first paragraph, as
12 containing subject matter which was not described in the specification in such a
13 way as to reasonably convey to one skilled in the relevant art that the inventor(s),
14 at the time the application was filed, had possession of the claimed invention.
15 Specifically, the support part being made of several parallel beams" is not
16 supported by the original specification (cl. 12). Also, the buffer being split up into
17 several pieces is not supported by the original specification (cl. 13, 14). In
18 addition, the connection between each of the arms and the support part being
19 made by a stirrup is not supported by the specification as originally filed (cl. 15).

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1 6. Claims 1-18 are rejected under 35 U.S.C. § 112, second paragraph, as
2 being indefinite for failing to particularly point out and distinctly claim the subject
3 matter which applicant regards as the invention.

4 In claim 1, step "b", the wording "one at least" should read --at least one--
5 in order to clarify that Applicant intends at least one of the arms to be movable,
6 not one of the arms to be at least movable (this same type of problem is seen
7 throughout the claims where the phrase "at least one" is used). Further, it is not
8 clear what is meant by "a so large thickness..." in step "c". These same problems
9 are seen in claims 2 and 16.

10 In claim 3, "said at least one substantially elastic buffer" lacks proper
11 antecedent basis.

12 In claim 4, the language "so that they could overlap" is vague and
13 indefinite. In general, the wording in this claim is vague, indefinite and confusing
14 (e.g. "each of all of said arms"; "the buffers of two first of said four arms";
15 "[could have their contact faces...").

16 In claim 7, "said two arms that are movable" lack proper antecedent basis.

17 In claim 15, it is not clear what a stirrup is.

18 In claim 16, lines 6 and 7, "said method for holding objects by clamping
19 without any risk at all of damaging" lacks proper antecedent basis.

Claim Rejections - 35 USC § 103

It would have been obvious to one of ordinary skill in the art, at the time of invention, to provide the clamping arms of Neff with elastic pads, in light of the teachings of Thornton, in order to protect the object being clamped. Note that the

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1 contact faces of Neff are at right angles to the support part and that the pads
2 taught by Thornton can be considered rings which cover the end of each arm.

3 The arms of Neff are manually moved into contact with the object being
4 held and are then released so as to lock each of the arms by tilting them against
5 the support part. Note that the support part of Neff can be considered to be made
6 of several beams connected together by couplers as claimed in claim 11 and that
7 the elastic buffer can be considered to be split up into pieces.

8 9. Claims 4-6 are rejected under 35 U.S.C. § 103 as being unpatentable over
9 Neff in view of Thornton as applied to claims 1-3 and 11-16 above, and further in
10 view of the EPO 0080960 patent to Berna.

11 Neff in view of Thornton teach the invention except for additional sets of
12 movable arms placed on the support part.

13 Berna, in figure 3 of the EPO patent, teaches providing a support part of a
14 clamping device with multiple sets of movable arms.

15 It would have been obvious to one of ordinary skill in the art, at the time of
16 invention, to provide the support part of Neff/Thornton with additional movable
17 arms, in light of the teachings of Berna, in order to be able to hold more than one
18 object at a time. Note that one of ordinary skill would be fully capable of adding
19 additional sets (more than two) of movable arms to the support part, depending on
20 the number of objects being held.

10. Claim 7 is rejected under 35 U.S.C. § 103 as being unpatentable over Neff in view of Thornton as applied to claims 1-3 and 11-16 above, and further in view of Ditto.

Ditto teaches providing a support part in a clamp with an end cap 32.

It would have been obvious to one of ordinary skill in the art, at the time of invention, to provide the support part of Neff/Thornton with an end cap, in light of the teachings of Ditto, in order to protect the users hand. Note that the end cap of Ditto can function as a stop and is removable from the support part.

11. Claims 8, 9, 10, 17 and 18 would be allowable for the reasons cited in paper #16 relating to previous claims 8, 9, 13 and 14 if rewritten to overcome the rejections under 35 U.S.C. § 112 and to include all of the limitations of the base claim and any intervening claims.

12. Documents related to the instant application may, during prosecution within the group, be submitted to the Group 3200 facsimile center at (703) 305-3579/3580. The faxing of such documents must conform with the notice


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1 published in the Official Gazette, 1096 OG 30 (October 19, 1988). Applicant is
2 reminded to clearly mark any facsimile transmission as "DRAFT" if it is not to be
3 considered as an official response.

4 13. Any inquiry concerning this communication should be directed to Examiner
5 Tom Hughes at telephone number (703) 308-1806.
6

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8 
9 S. THOMAS HUGHES
10 PRIMARY EXAMINER
11 GROUP 3200
12

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14 sth

15 October 15, 1996